

Nuclear Regulatory Commission

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period as may be granted by the Commission, to remedy any breach of any covenant or agreement referred to in paragraph (a)(11)(iv) of this section or to show cause why the license should not be modified or revoked.

(13) An exclusive licensee shall be granted the right to sue at his own expense any party who infringes the rights set forth in his license and covered by the licensed patent. The licensee may join the Government of the United States, upon consent of the Attorney General, as a party complainant in such suit, but without expense to the Government and the licensee shall pay costs and any final judgment or decree that may be rendered against the Government in such suit. The Government shall have an absolute right to intervene in any such suit at its own expense. The licensee shall be obligated to furnish promptly to the Government, upon request, copies of all pleadings and other papers filed in any such suit and of evidence adduced in proceedings relating to the licensed patent, including, but not limited to, negotiations or settlements and agreements settling claims by a licensee based on the licensed patent, and all other books, documents, papers, and records pertaining to such suit. If, as a result of any such litigation, the patent shall be declared invalid, the licensee shall have the right to surrender his license and be relieved from any further obligation thereunder.

(14) A licensee may surrender his license at any time prior to termination of the license upon notice thereof to the Commission, and upon approval of the Commission, but the licensee shall not be relieved of the obligations thereunder without specific approval of the Commission.

(15) The license may be subject to such other terms and conditions as the Commission may deem in the public interest.

§ 81.35 Notices to public of exclusive licenses.

The Commission will have published in the FEDERAL REGISTER notices of the granting, revocation, or modification in duration and/or scope, of limited exclusive licenses under these regulations. Such notices shall identify the

invention and shall include, directly, or by reference to previous notice(s) in the FEDERAL REGISTER pursuant to § 81.13 or § 81.30(a)(3) the following:

- (a) Identification of the licensee.
- (b) Duration and scope of the exclusive license.
- (c) That such a license is being granted or revoked, or the nature of the modification of the license.
- (d) The effective date of the grant, modification, or revocation.

§ 81.40 Contents of a license application.

(a) *Nonexclusive license application.* An application for a nonexclusive license under an NRC invention should be accompanied by a fee of ten dollars (\$10) for processing the application and must include the following information:

- (1) Identification of the invention for which the license is desired, including the patent application serial number or the patent number, title, and date, if known, and any other identification of the invention;
- (2) Name and address of the person, company, or organization applying for a license and the citizenship or State of incorporation thereof;
- (3) Name and address of a representative of applicant to whom correspondence should be sent and any notices served;
- (4) Nature and type of applicant's business;
- (5) Identification of the source of applicant's information concerning the availability of a license on the invention;
- (6) Purpose for which the license is desired, and a brief description of applicant's plan to achieve that purpose;
- (7) A statement of the field and the field(s) of use in which applicant intends to practice the invention; and
- (8) A statement of the geographical area(s) in which the applicant will practice the invention.

(b) *Exclusive license application.* An application for a limited exclusive license should include, in addition to the information indicated above for a non-exclusive license application, the following information:

- (1) Applicant's status, if any, in any one or more of the following categories:

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- (i) Small business firm;
- (ii) Minority business enterprise;
- (iii) Location in a surplus labor area;
- (iv) Location in a low income area;

and

- (v) Location in an economically depressed area.

(2) A statement describing the time, expenditure, and other acts which the applicant considers necessary to bring the invention to a point of practical application, and the applicant's offer to invest that time and sum, and to perform such acts, if the license is granted.

(3) A statement of applicant's capability to undertake the development and/or marketing required to bring the invention to the point of practical application.

(4) A statement that contains applicant's best knowledge of the extent to which the invention is being practiced by private industry and the Government; and

(5) Any other facts which the applicant believes to show it to be in the public interest for the Commission to grant an exclusive license rather than a nonexclusive license and that such exclusive license should be granted to the applicant.

§ 81.50 Additional licenses.

Subject to any outstanding licenses, nothing in this subpart shall preclude the Commission from granting additional nonexclusive and limited exclusive licenses for inventions covered by this subpart when the Commission determines that to do so would provide for an equitable exchange of patent rights. The following exemplify circumstances wherein such licenses may be granted:

(a) In consideration of the settlement of interferences;

(b) In consideration of a release of any claims;

(c) In exchange for or as part of the consideration for a license under adversely held patent(s); or

(d) In consideration for the settlement or resolution of any proceeding under the Act or other statute.

§ 81.51 Appeals.

An applicant for a license, a licensee, or a third party who has participated

under § 81.30(a)(3) shall have the right to appeal in accordance with the appeal procedures of this subpart any decision of the Commission concerning the grant, denial, interpretation, modification, or revocation of a license under this subpart, by filing a notice of appeal with the Commission within thirty (30) days from the date of the mailing of a notice by the Commission of the decision or, if no such notice to the person desiring to appeal, then thirty (30) days from publication in the FEDERAL REGISTER of the facts which show such a decision. The notice of appeal shall specify the portion of the decision from which the appeal is taken, and the reasons why the decision is erroneous. A statement of fact and argument in the form of a brief in support of the appeal may be submitted with the notice of appeal or, if the appellant prefers, may be filed with the Commission within fifteen (15) days after the filing of the notice of appeal. If a statement of fact and argument in the form of a brief in support of the appeal is not submitted with the notice, the appellant shall state in the notice whether such a statement of fact and argument in the form of a brief in support of the appeal will be filed.

§ 81.52 Appeals Board.

(a) *NRC Invention Licensing Appeal Board.* Upon notice of an appeal in accordance with § 81.51, the Executive Director for Operations of the Nuclear Regulatory Commission will designate within thirty (30) days an Invention Licensing Appeal Board (hereinafter, Board) to decide such an appeal.

(b) *Composition of the Board.* The Invention Licensing Appeal Board shall consist of three members having equal voting power, one of whom will be designated as Chairman.

(c) *Notice of designation of the Board.* The Executive Director for Operations of the Nuclear Regulatory Commission will advise the appellant of the designation of the Board, its composition, and Chairman.

[40 FR 8793, Mar. 3, 1975]

§ 81.53 Review by the Board.

(a) The Board shall determine the propriety of any decision concerning